

REMARKS/ARGUMENTS

The office action of November 22, 2004 has been carefully reviewed and these remarks are responsive thereto. Claims 25, 28, 30, 36, 39, and 40 have been amended, and claims 47 and 63-68 have been canceled. Claims 1-28, 30, 32-33, 36-45, 49-51, 53-62, and 69-75 thus remain pending in this application after entry of the present amendment. Reconsideration and allowance of the instant application are respectfully requested.

Applicant acknowledges the allowance of claims 43 and 44, and the indication that claims 11, 12, 17, 19-21, 24, 26, and 71-72 contain allowable subject matter.

Rejections Under 35 U.S.C. § 102

Claims 28, 36-39, and 74 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Armstrong *et al.* (U.S. Pat. No. 5,729,219, hereinafter Armstrong). Applicant respectfully traverses this rejection for at least the following reasons.

In the Office Action dated February 26, 2004, independent claim 28 was previously rejected under 35 U.S.C. § 102(b) as being anticipated by Armstrong. Applicant submitted arguments in response to the rejection on May 10, 2004. In a subsequent Office Action dated August 9, 2004 the examiner indicated that Applicant's arguments were persuasive, but moot in view of new grounds of rejection. The Applicant having traversed those new grounds of rejection, the pending Office Action now again rejects amended¹ claim 28 as anticipated by Armstrong. However, the Office Action fails to address Applicant's previous arguments set forth in the May 10, 2004, amendment, and also fails to address all the elements of claim 28, ignoring the recitation "wherein the first touch-sensitive input area is resistant to sound interference," which was specifically addressed by the Applicant in the May 10, 2004, amendment. Thus, the rejection is non-responsive in that it fails to address Applicant's previous arguments with respect to the prior rejection of claim 28 over Armstrong, and the rejection is deficient because it fails to address each recitation of claim 28. Claims 36-39, and 74 are dependent back to claim 28 and are thus allowable for at least the same reasons as claim 28. The rejection is respectfully traversed.

¹ Applicants have amended claim 28 to recite a planar touchpad to clarify that the touchpad of claim 28 is two-dimensional.

Claims 28, 30, 36-40, 47, 59-62, 74, and 75 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 103(a) as obvious over Hayes, Jr., *et al.* (U.S. Pat. No. 6,131,047, hereinafter Hayes). Applicant respectfully traverses this rejection for at least the following reasons.

Amended independent claim 28 recites, *inter alia*, “wherein the first planar touch-sensitive input area is resistant to sound interference, said first planar touch-sensitive input area comprising a touchpad....” Hayes, however, fails to teach or suggest a planar touch-sensitive input area comprising a touchpad that is resistant to sound interference. The plurality of keys 130 referred to by the Office Action are not a planar touch-sensitive input area comprising a touchpad, as recited in the claim. In addition, Hayes makes no mention of any sound resistant qualities of a planar touch-sensitive input area comprising a touchpad. Claims 36-39, and 74, dependent back to claim 28, are allowable over Hayes for at least the same reason as claim 28.

Amended independent claim 40 recites, *inter alia*, “a touch-sensitive sound resistant planar input device covering a first face of the casing, wherein the planar input device comprises at least one hole through which sound emitted from the speaker passes.” However, even if the keys 130 of Hayes were somehow considered to be a touch-sensitive sound resistant planar input device, which Applicant maintains they are not, there are no holes in the keys 130 of Hayes.

Independent claim 47 has been canceled, thus rendering the rejection moot with respect to this claim.

This rejection has been respectfully traversed.

Rejections Under 35 U.S.C. § 103

Claims 1-10, 13-16, 18, 22, 23, 25, 27, 32, 33, 41, 42, 45, 49-51, 53-58, 63-69, 73, and 75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayes, Jr. in view of Armstrong.

No Motivation to Combine Hayes with Armstrong

Applicant traverses this rejection, as there is no motivation or suggestion in the prior art to have combined Hayes with Armstrong as proposed. The Office Action alleges that it would have been obvious to combine Hayes with Armstrong because the combination “would provide improved GUIs, which are effectively and conveniently performed to provide the enhanced functionality and reliability of user’s inputs by enabling the use of two opposing major surfaces and side surfaces to provide touch-sensitive strips or touch pads.” This is not a motivation to combine references, however, but rather is the conclusion the examiner has apparently reached after having benefited from reading Applicant’s own disclosure. Indeed, the Office Action does not indicate where in the prior art there was a suggestion that improved GUIs were needed, or why one would have been motivated to enable the use of two opposing major surfaces and side surfaces to provide touch-sensitive strips or touch pads. The combination is thus an improper combination based on hindsight.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembicza*k, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Even assuming, *arguendo*, that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office Action provide any evidence that the combination does not include knowledge gleaned only from Applicant’s disclosure.

Thus, Applicants respectfully submit that that there is no motivation or suggestion to combine Hayes with Armstrong.

Even if Improperly Combined, the Claims are Not Taught by the Combination

Even if Hayes and Armstrong were combined as proposed, which Applicant maintains would be improper, the combination does not teach or suggest all the recitations of the rejected claims.

Independent claim 1 recites, *inter alia*, “control logic for manipulating content displayed on the display screen responsive to user input via the first, second, third, and planar input devices.” The combination, however, would only use three input devices, not four. Hayes only uses two touch strips at any given time, and the addition of Armstrong, at best, only further provides a touchpad. Thus, claim 1 is allowable even if Hayes and Armstrong are improperly combined. Claims 2-10, 13-16, 18, 22, 23, 25, and 27, which are dependent back to claim 1, are also allowable for at least the same reasons as claim 1, and further in view of the additional features recited therein.

For example, with respect to claim 13, the improper combination of Hayes and Armstrong does not teach or suggest “the control logic causes the portable device to enlarge and reduce the image displayed on the display screen responsive to input received through the third linear input device.”

With respect to claims 15 and 16, the improper combination of Hayes and Armstrong does not teach or suggest “a speaker that outputs sound through at least one hole extending through the back face and the planar input device.”

With respect to claim 27, the improper combination of Hayes and Armstrong does not teach or suggest “at least one of the first, second, and third linear input devices comprise a region of the touch-sensitive planar input device extending beyond the displayable area of the display screen.”

Independent claim 45 is allowable for similar reasons as claim 28, discussed above.

With respect to dependent claims 32, 49 and 57 (which are also allowable based on base claims 28, 45, and 30, respectively), the improper combination of Hayes and Armstrong does not teach or suggest altering a size of an image displayed on the display screen as claimed.

With respect to dependent claims 33, 50 and 58 (which are also allowable based on base claims 28, 45 and 30, respectively), the improper combination of Hayes and Armstrong does not teach or suggest panning the content displayed on the display screen as claimed.

Claims 63-68 have been cancelled, rendering the rejection moot with respect to these claims.

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With respect to claim 69, which is also allowable based on the allowability of base claim 40, the improper combination of Hayes and Armstrong does not teach or suggest a touch sensitive sound resistant touchpad as claimed.

The remaining dependent claims are allowable at least based on the allowability of their respective base claims, and this rejection is respectfully traversed.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

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